

### **Remarks/Arguments**

Applicants have received and carefully reviewed the Office Action of the Examiner mailed March 3, 2009. Currently, claims 1-44 remain pending. Claims 1-44 have been rejected. Claims 1, 16, and 31 have been amended to clarify the relationships among the elements. Favorable consideration of the following remarks is respectfully requested.

### **Claim Rejections – 35 USC § 102**

Claims 1, 5-7, 12, and 13 were rejected under 35 U.S.C. 102(b) as anticipated by Fleischhacker et al. (U.S. Patent No. 6,210,395), hereinafter Fleischhacker. After careful review, Applicant must respectfully traverse this rejection.

*“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”*

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). Nowhere does Fleischhacker appear to teach or suggest, “wherein the coil assembly has a first generally cylindrical section having a first inner diameter that is greater than or equal to the outer diameter of the shaft; and a second generally cylindrical section having a second inner diameter greater than the first inner diameter and joined to the first generally cylindrical section by a proximally reducing taper”, as recited in claim 1.

Instead, Fleischhacker appears to teach a coil assembly having a single coil section with an inner diameter no larger than distal region (102) to which it is attached. There does not appear to be a second coil section and there does not appear to be “a proximally reducing taper” joining a first and second section. For at least these reasons, Fleischhacker does not appear to disclose *each and every element as set forth in the claim* and Applicants respectfully request that the rejection of claim 1 be withdrawn.

Additionally, for similar reasons as well as others, claims 5-7, 12, and 13, which depend from claim 1, and include significant additional limitations, are believed to be not anticipated by Fleischhacker and Applicants respectfully request that the rejections be withdrawn.

### **Claim Rejections – 35 USC § 103**

Claims 2-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischhacker, as applied to claim 1, in view of DeMello et al. (U.S. Patent No. 5,429,597), hereinafter DeMello. After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). As discussed previously, nowhere does Fleischhacker appear to disclose “wherein the coil assembly has a first generally cylindrical section having a first inner diameter that is greater than or equal to the outer diameter of the shaft; and a second generally cylindrical section having a second inner diameter greater than the first inner diameter and joined to the first generally cylindrical section by a proximally reducing taper”, as recited in claim 1. The disclosure of DeMello appears to be limited to a two layer coil of uniform inner diameter which forms the shaft (20) rather than being attached to the outer surface of the distal end of a shaft. Therefore, Fleischhacker in view of DeMello does not appear to teach all the claim limitations of independent claim 1, as is required to establish a *prima facie* case of obviousness.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Applicants believe that claims 2-4, which depend from nonobvious independent claim 1, are also nonobvious and respectfully request that the rejections be withdrawn.

With respect to claims 8-10 which were rejected under 35 U.S.C. 103(a) over Fleischhacker, Applicants believe that claims 8-10, which depend from nonobvious independent claim 1, are also nonobvious and respectfully request that the rejections be withdrawn. Further, the discussion of DeMello as applied to these claims appears to be irrelevant in that the claims were not rejected over Fleischhacker in view of DeMello.

Applicants note that DeMello does not appear to overcome the deficiencies of Fleischhacker as applied to claim 1.

Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischhacker, as applied to claim 1, in view of Samson et al. (U.S. Patent No. 6,143,013), hereinafter Sampson. After careful review, Applicant must respectfully traverse this rejection.

Sampson, like DeMello, appears to disclose a catheter in which the coil forms the catheter body rather than a coil assembly which is disposed about the distal end of a shaft. Further, Sampson appears to teach coils which have a distally reducing taper and thus does not appear to overcome the deficiencies of Fleischhacker as applied to independent claim 1. Accordingly, Fleischhacker in view of Sampson does not appear to teach all the claim limitations of independent claim 1, as is required to establish a *prima facie* case of obviousness.

Applicants believe that claim 11, which depends from nonobvious independent claim 1, is also nonobvious and respectfully request that the rejections be withdrawn.

Claims 14 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fleischhacker, as applied to claim 1, in view of Chien et al. (U.S. Patent No. 6,165,163), hereinafter Chien. After careful review, Applicant must respectfully traverse this rejection.

Chien, like DeMello and Sampson, appears to disclose a catheter in which the coil forms the catheter body rather than a coil assembly which is disposed about the distal end of a shaft. Accordingly, Fleischhacker in view of Chien does not appear to teach all the claim limitations of independent claim 1, as is required to establish a *prima facie* case of obviousness.

Applicants believe that claims 14 and 15, which depend from nonobvious independent claim 1, are also nonobvious and respectfully request that the rejections be withdrawn.

Claims 16, 20-25, 27, 28, 31, 35-40 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsburg (U.S. Patent No. 6,165,163) in view of Fleischhacker. After careful review, Applicant must respectfully traverse this rejection.

Ginsburg appears to disclose a sheath for an embolic protection device, rather than an embolic protection sheath, said sheath having a uniform inner diameter along its entire length. Further, the sheath does not appear to include a coil other than the single turn, single layer reinforcement ring (28). It would appear that adding a coil assembly, acknowledged by the Examiner to be missing from Ginsburg, would result in a sheath substantially identical to the sheath said to be disclosed by Fleischhacker as discussed in some detail above. Amended claims 16 and 31 include the limitation: "wherein the coil assembly has a first generally cylindrical section having a first inner diameter that is greater than or equal to the outer diameter of the shaft; and a second generally cylindrical section having a second inner diameter greater than the first inner diameter and joined to the first generally cylindrical section by a proximally reducing taper". Fleischhacker does not appear to overcome the deficiencies of Ginsburg for at least this reason and Applicants respectfully request that the rejections of claims 16 and 31 be withdrawn.

Applicants believe that claims 20-25, 27, 28, 35-40 and 42, which depend from nonobvious independent claims 16 and 31 respectively, are also nonobvious and respectfully request that the rejections be withdrawn. As before, the discussion of DeMello appears to be irrelevant to these rejections for the reason that the DeMello reference is not cited in the rejection; however DeMello does not appear to overcome the deficiencies of Ginsburg in view of Fleischhacker as applied to independent claims 16 and 31.

Claims 17-19 and 32-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginsburg in view of Fleischhacker, as applied to claims 16 and 31 above, and in view of DeMello.

As discussed above, DeMello appears to disclose a catheter shaft in which the elongated shaft is formed by a dual coil structure. Accordingly, DeMello does not appear to overcome the deficiencies of Ginsburg in view of Fleischhacker as discussed above and applied to nonobvious independent claims 16 and 31.

Applicants believe that claims 17-19 and 32-34, which depend from nonobvious independent claims 16 and 31 respectively, are also nonobvious and respectfully request that the rejections be withdrawn.

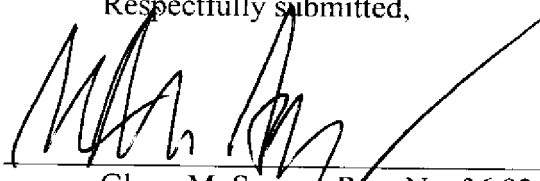
Similarly, the rejections of claims 26 and 41 under 35 U.S.C. 103(a) as being unpatentable over Ginsburg in view of Fleischhacker, as applied to claims 16 and 31 above, and in view of Sampson, as well as the rejections of claims 29, 30, 43, and 44 under 35 U.S.C. 103(a) as being unpatentable over Ginsburg in view of Fleischhacker, as applied to claims 16 and 31, and in view of Chien, are inappropriate in that neither Sampson nor Chien overcome the deficiencies of Fleischhacker for reasons discussed above. Accordingly, Applicants believe that claims 26, 29, 30, 41, 43, and 44, which depend from nonobvious independent claims 16 and 31 respectively, are also nonobvious and respectfully request that the rejections be withdrawn.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
[Glenn.Seager@cstlaw.com](mailto:Glenn.Seager@cstlaw.com)  
Tel: (612) 677-9050  
Fax: (612) 359-9349